

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Paul A. J. Janssen et al.

Application No.: 10/573,364

Confirmation No.: 2729

Filed: March 24, 2006

Art Unit: 1622

For: HIV REPLICATION INHIBITING PURINE
DERIVATIVES

Examiner: M. L. BERIC

**APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR
RECONSIDERATION UNDER 37 CFR §1.705(b)**

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

1. This is a request for reconsideration of the patent term adjustment of 417 days indicated in the determination of Patent Term Adjustment under 35 USC 154(b) that was attached to the Notice of Allowance mailed April 26, 2011 for the above-referenced application. It is respectfully requested that Applicants be granted a minimum patent term adjustment of 569 days.

2. In accordance with 37 CFR § 1.705(b)(1), please charge our Credit Card in the amount of \$200.00 covering the fees set forth in 37 CFR §1.18(e). The U.S. Patent and Trademark Office is authorized to charge any additional fees that may be required in conjunction with this

submission to Deposit Account Number 50-2228, under Order No. 026038.0281PTUS, from
which the undersigned is authorized to draw.

Dated: July 13, 2011

Respectfully submitted,

By 
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STATEMENT UNDER 37 CFR § 1.702(b)

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

1. This statement is respectfully submitted in support of the “Application for Patent Term Adjustment Including Request for Reconsideration Under 37 CFR § 1.705(b)” for the above-referenced application. In view of the following, it is respectfully requested that Applicants be granted a minimum patent term adjustment of **569 days**.
2. The patent term adjustment on the Determination of Patent Term Adjustment Under 35 U.S.C. §154(b), which was attached to the Notice of Allowance, is 417 days (a copy of which is attached). This determination of 417 days is in error because, pursuant to 35 U.S.C. § 154(b), the Office failed to properly account for the days lost to Patent Office Delays under 37 CFR § 1.702(a)(1) and § 1.703(a)(1), in conjunction with the Patent Office’s delays in issuing a patent within three (3) years of filing the above-referenced application under 37 CFR § 1.702(b) and 1.703(b), as provided in *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010).

3. Pursuant to 37 CFR § 1.702, the correct patent term adjustment should be 569 days. The correct patent term adjustment of 569 days accounts for the delay times for:

- (a) failure of the Patent Office to issue a patent within three (3) years of the 35 U.S.C. § 371 National Stage Commencement date (filing date) of March 24, 2004, which totals a delay of 152 days excluding the number of days beginning on the date on which a request for continued examination was filed and ending on the date the patent issues, 35 U.S.C. § 154(b)(1)(B), 37 CFR §§ 1.702(b), 1.703(b)(1);
- (b) failure to provide a first action within fourteen (14) months of the 35 U.S.C. § 371 completion date of March 25, 2006, wherein the first action was not received until October 8, 2008, which totals a delay of 502 days based on the fulfillment of the requirements of 35 U.S.C. § 371, 35 U.S.C. § 154(b)(1)(A)(i), 37 CFR §§ 1.702(a)(1), 1.703(a)(1); and
- (c) failure of the Patent Office to respond to the Amendment and Response dated December 16, 2009 until June 17, 2010, which totals a delay of 62 days based on the Patent Office's failure to respond within 4 months after the reply was filed, 35 U.S.C. § 154(b)(1)(A)(ii), 37 CFR §§ 1.702(a)(1), 1.703(a)(2),(3).

Furthermore, the correct patent term adjustment of 569 days accounts for Applicant delays under 37 CFR § 1.704(b), wherein Applicants were debited a total of 147 days for:

- (a) failing to respond to the October 8, 2008 Non-Final Office Action until May 9, 2009 (60 day delay), 35 U.S.C. § 154(b)(2)(C)(ii), 37 CFR § 1.704(b);
- (b) failing to respond to the April 23, 2009 Final Office Action until August 24, 2009 (32 day delay), 35 U.S.C. § 154(b)(2)(C)(ii), 37 CFR § 1.704(b);

- (c) failing to respond to the June 17, 2010 Final Office Action until October 14, 2010 (27 day delay), 35 U.S.C. § 154(b)(2)(C)(ii), 37 CFR § 1.704(b); and
- (d) failing to respond to the November 2, 2010 Final Office Action until March 2, 2011 (28 day delay), 35 U.S.C. § 154(b)(2)(C)(ii), 37 CFR § 1.704(b).

In addition, the correct patent term adjustment accounts for any overlap regarding the differences between patent term extension periods under 37 CFR § 1.702(b), 1.703(b) and all other sections of Code regarding Patent Office Delays, which is set forth under 37 CFR § 1.703(f) regarding calculation of correct patent term adjustments.

4. The above-referenced application is not subject to any terminal disclaimers.
5. There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 37 CFR § 1.704 beyond the above-discussed Applicant delay.
6. As set forth in 37 CFR §1.703(f), Applicants are entitled to a period of patent term adjustment equal to the period of examination delays reduced by the period of Applicant Delay and examination delay overlap days. Therefore, Applicants submit that the correct patent term adjustment for the above-referenced application is **at least 569 days**, which is the difference between the total period of examination delay (716 days) and the period of Applicant Delay (147 days). **As such, the correct patent term adjustment upon issuance of a patent is expected to be the sum of 569 days (as calculated herein).**
7. In accordance with 37 CFR§ 1.705(b)(2)(iii), Applicants submit that the pending patent corresponding to this application will not be subject to a terminal disclaimer.

In view of the foregoing, it is respectfully requested that this Application for Patent Term Adjustment be favorably considered and that a corrected Determination of Patent Term Adjustment be issued to reflect a minimum patent term adjustment of 569 days. To the extent this petition is dismissed as being premature, Applicants expressly reserve the right to file a petition for patent term adjustment within the specified period after issuance of the patent.

Dated: July 13, 2011

Respectfully submitted,

By 
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(703) 744-8063
(703) 744-8001 (Fax)
Attorney for Applicant

ATTACHMENTS:

(a) Determination of Patent Term Adjustment under 35 U.S.C. §154(b)



UNITED STATES PATENT AND TRADEMARK OFFICE

Exhibit A

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,364	03/24/2006	Paul Adriaan Jan Janssen	PRD-2100USPCT	2729
27777	7500	04/26/2011	EXAMINER [REDACTED]	BERCH, MARK L
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			ART UNIT 1622	PAPER NUMBER
				DATE MAILED: 04/26/2011

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)

(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 417 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 417 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.